

***Remarks***

Claims 1-30, 32, and 34-36 are presented for reconsideration, with 1, 27, 35, and 36 being the independent claims. Claims 35 and 36 are sought to be added. Claims 1, 2, 21, 26, 27, and 29 are sought to be amended. Claims 31 and 33 are sought to be cancelled without prejudice or disclaimer. Applicants reserve the right to prosecute similar or broader claims, with respect to the amended and cancelled claims, in the future. No new matter has been entered by any amendments.

Based on the above amendments and following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

***Rejection under 35 U.S.C. § 112, second paragraph***

Claims 1 and 27 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Although Applicants disagree with the rejection, Applicants have amended the claims in order to expedite prosecution. In view of the amendments shown above, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

***Rejection under 35 U.S.C. §§ 102(b) and 103(a) using Maase***

Claims 1, 2, 4-7, 9-11, 13, 14, 20, 23, and 27-29 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,528,355 to Maase et al. ("Maase"). Claims 8, 14-19, 21, 24, 31, and 33 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Maase. Applicants traverse these rejections.

Based on the canceling of claims 31 and 33, Applicants believe the rejection of these claims has been rendered moot.

Claims 1 and 27 distinguish over the applied reference. For example, claims 1 and 27 recite "wherein the image data represents substantially all of the print area of the hand of the person, while the hand is stationary on the non-planar prism."

The Examiner asserts on pages 10-11 of the final Office Action that this feature (as substantially recited in previously pending claims 31 and 33) is obvious in view of

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Maase. However, the Examiner has failed to establish a prima facie case of obviousness because the Examiner's conclusionary statements without any evidence are impermissible hindsight and especially in view of the fact that Maase explicitly teaches away from this feature.

The Examiner has failed to establish a prima facie case of obviousness because there is no legal basis for the Examiner's conclusion that Maase could have included certain sized optical surfaces, as argued on pages 10-11 of the final Office Action. Thus, the Examiner has used impermissible hindsight, which is not permitted under the prevailing patent laws. *Continental Can Company v. Monsanto Company*, 948 F.2d 1264, 1271, 20 USPQ2d 1746, 1751 (Fed. Cir. 1991) ("When prior art references require selective combination ... there must be some reason for the combination other than the hindsight gleaned from the invention itself."); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 1072 30 USPQ2d 1377,1380 (Fed. Cir. 1993) ("The motivation to combine references can not come from the invention itself."); *Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) ("Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.").

Also, the Examiner has failed to establish a prima facie case of obviousness because Maase teaches away from this feature. See M.P.E.P. Section 2144.05(III). Maase explicitly teaches away from this feature because Maase requires rotation of hand 18 between scans to capture both palm 62 and heel 70 of hand 18 (see, e.g., col. 2, lines 50-56). Maase teaches non-planar platen 12 includes an upper surface 28 having inner section 11a, b with a convex shape and an outer section 13a, b with a planar shape (cols. 3-6). These two shapes of upper surface 28 are required to allow capture of a palm 62 of a hand 18 with inner section 11a, b and a heel 70 of hand 18 with outer section 13a, b (cols. 2-6). The capture of both palm 62 and heel 70 is required to take place during two scans, one to capture palm 62 and one to capture heel 70 (col. 2, lines 50-56).

Therefore, Maase does not teach or suggest "wherein the image data represents substantially all of the print area of the hand of the person, while the hand is stationary on the non-planar prism," as recited in claims 1 and 27. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1

and 27. Also, at least based on their respective dependencies to claims 1 and 27, claims 2-26, 28-30, 32, and 34 should be found allowable over the applied patent.

***Rejections under 35 U.S.C. §103(a)***

Claims 3, 12, 22, and 30 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Maase in view of U.S. Patent No. 4,684,802 to Hakenworth et al. (“Hakenworth”). Claims 25 and 26 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Maase in view of U.S. Patent No. 5,825,474 to Maase (“Maase II”). Claims 32 and 34 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Maase in view of U.S. Patent No. 4,790,260 to Asano et al. (“Asano”). Applicant traverses these rejections.

None of these applied references, Hakenworth, Maase II, or Asano, are being used by the Examiner to teach or suggest “wherein the image data represents substantially all of the print area of the hand of the person, while the hand is stationary on the non-planar prism,” as recited in claims 1 and 27. Neither do any of these references teach or suggest this feature. Thus, these applied references fail to cure the deficiencies in Maase. Therefore, the Examiner has failed to provide a prima facie case of obviousness. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw these rejections, and find the respective claims allowable over the applied references.

***New Claims 35 and 36***

Claims 35 and 36 include features that distinguish the claims from the applied references.

For example, claim 35 recites “wherein the scanning optical system captures image data representing a first print area of a palm and a second print area of a side of a hand extending from the palm up the side of the hand while the palm and the side of the hand are interacting with and stationary on the non-planar prism.” As discussed above, none of the applied references teach or suggest at least “while the palm and the side of

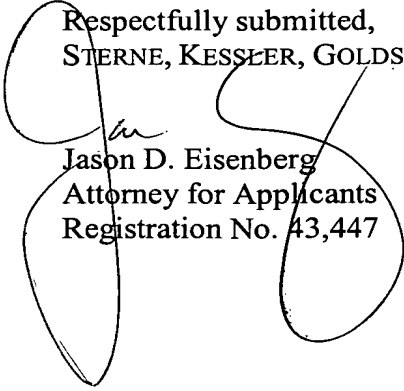
the hand are interacting with and stationary on the non-planar prism,” as recited in claim 35. Accordingly, claim 35 should be found allowable over the applied references.

As another example, claim 36 recites “wherein the scanning optical system captures the image data representing the palm print and the side hand print while the hand is interacting with and stationary on the conically-shaped prism.” None of the applied references teach or suggest capturing print information using a conically-shaped prism, as recited in claim 36. Also, none of the applied references teach or suggest “while the hand is interacting with and stationary on the conically-shaped prism,” as recited in claim 36. Accordingly, claim 36 should be found allowable over the applied references.

### ***Conclusion***

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,  
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

  
Jason D. Eisenberg  
Attorney for Applicants  
Registration No. 43,447

Date: 5/24/06  
1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600 SKGF\_DC1: 523814.1